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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,827	10/11/2001	Mitsuyuki Hatanaka	275785US6	2274

22850 7590 12/21/2006  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
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2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/975,827

Applicant(s)

HATANAKA ET AL.

Examiner

Tom Gyorf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-19, 21-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-19, 21-23 and 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-15, 17-19, 21-23 and 25-28 remain for examination. The correspondence filed 10/12/06 amended claims 1, 3-14, 18, and 22; and added claims 26-28.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-15, 17-19, 21-23 and 25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-15, 17-19, 21-23 and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Shoda et al. (U.S. Patent 7,096,268).

Regarding claims 1, 3, and 4:

Shoda discloses an information processing method/apparatus/program having functions for recording contents on a first recording medium onto a storage unit of said

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apparatus, said apparatus comprising: a recording unit for recording the contents of the first recording medium onto the storage unit (col. 6, lines 54-57); a storing unit for storing information regarding each track on the first recording medium as recording history information in said apparatus at the time the contents of the first recording medium are recorded onto the storage unit by said recording unit (col. 6, lines 58-67); a determining unit for determining whether a track on the first recording medium was previously recorded or not onto the storage unit by said recording unit based on said recording history information stored in said apparatus (col. 8, lines 23-55); and a display control unit for controlling display of information regarding a track that was not previously recorded as determined by said determining unit, wherein said display control unit initially indicates the track was not previously recorded as being selected for recording by said recording unit from the first recording medium to the storage unit (col. 9, lines 23-50).

Regarding claims 14, 18, and 22:

Shoda discloses an information processing method/apparatus/program for transferring contents from a first recording medium to a second recording medium, said apparatus comprising: means for determining whether or not recorded history information is present in the apparatus for the contents of the first recording medium (col. 8, lines 23-50); means for selecting a portion or portions of the contents for recording from the first recording medium to the second medium (col. 7, lines 4-12, and Figure 7); means for recording the selected portion from the first recording medium to

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the second recording medium (col. 8, line 61 – col. 9, line 2); means for storing the recorded history information regarding the selected portion[s] of the recorded contents (col. 7, line 55-col. 8, line 12); means for displaying a list indicating the selected portion[s] and non-selected portion[s] of the content (Figure 13a); wherein said recording means records from the first recording medium to the second recording medium the displayed portion[s] (col. 6, lines 34-40); and wherein said selecting means initially, automatically selects portion[s] of the contents of the first recording medium for recording that do not have recorded history information present in said apparatus, and wherein said selecting means initially does not select portion[s] of the contents of the first recording medium for recording that have recorded history information present in said apparatus (col. 11, line 62 – col. 12, line 35).

Regarding claim 2:

Shoda further discloses wherein said recording history information contains audio recording history information which records the number of times that audio recording has been made for each track of the first recording medium, title saving information of the contents, and play list information (col. 5, line 65 – col. 6, line 7; col. 7, lines 55-65).

Regarding claims 5, 8, and 11:

Shoda further discloses checking-in means for rendering unusable the contents recorded onto a second medium from the first recording medium (col. 7, line 55 – col. 8, line 12), wherein storing unit is further configured for storing information regarding the

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contents as recording history information onto the second recording medium being rendered unusable (col. 8, lines 13-55); wherein said recording history information includes a check-out number which is decremented when said recording unit records the contents on the first recording medium onto the second recording medium; and incremented when said checking in means renders unusable the contents recorded onto the second recording medium from the first recording medium (Ibid, and col. 8, line 61 – col. 9, line 12).

Regarding claims 6, 9, 12, 15, 19, and 23:

Shoda further discloses wherein said display control unit displays indicia indicating manual selection or de-selection of tracks for recording by said recording unit from the first recording medium to the storage unit (elements 61 and 62 of Figure 13a; see also col. 7, lines 4-12 and col. 10, lines 45-60).

Regarding claims 7, 10, 13, 17, 21, and 25:

Shoda further discloses wherein said display control unit displays indicia indicating whether or not recorded history information is present in said apparatus for the contents of the first recording medium (e.g. Figures 7 and 9).

Regarding claims 26-28:

Shoda further discloses a judging unit for judging whether a predetermined recording medium is mounted to the apparatus based on a media specific identification

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information (col. 5, lines 25-30; element 67 of Figure 7); wherein said storing unit stores the recording history information associating with media specific information of the first recording medium (col. 9, lines 3-12) and wherein said determining unit determines when the first recording medium is mounted (col. 5, lines 25-30).

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

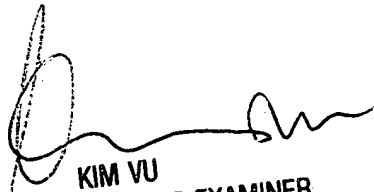
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG  
12/11/06



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